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3/13/08

In re Application of:
Belanger, Richard A
Serial No.: 10/538,325
Filed: Jun. 10, 2005
Docket: 70300-0103
Title: HOT MELT DISPENSER WITH
SILICONE VALVE

DECISION ON PETITION TO
WITHDRAW HOLDING OF
FINALITY

This is a decision on the petition filed on Feb. 8, 2008 to withdraw the finality of the Office Action of Dec. 10, 2007. The petition is being considered pursuant to 37 CFR § 1.181 and no fee is required for the petition.

The petition is **DISMISSED**.

In the petition, the applicants requested withdrawal of the finality of the Office action dated Dec. 10, 2007. Petitioner claims that the finality of the Office action is premature because the amendment of Sep. 20, 2007 did not necessitate the new grounds of rejection.

The record shows that:

1. On Jun. 20, 2007 the examiner mailed a non-final Office action. In the non-final Office action, claims 1, 4, 6 and 7 were rejected under 35 U.S.C. 102 as anticipated by Gordon et al (U.S. Pat. 3,884,396). Claims 2, 3 and 5 were rejected under 35 U.S.C. 103 as unpatentable over Gordon et al in view of Brown (U.S. 4,991,745) and Steinel (U.S. Pat. 6,575,340).
2. In response to the Office action mailed Jun. 20, 2007, the applicant filed an amendment on Sep. 20, 2007. Claims 1 and 4 were amended.
3. On Dec. 10, 2007 the examiner issued a final Office action. In the final Office action, claims 1, 2 and 4 were rejected under 35 USC 102(b) as anticipated by Flier (U.S. Pat. 4,616,768). Claims 3 and 5 were rejected under 35 USC 103 as unpatentable over Flier (U.S. Pat. 4,616,768) in view of Brown (U.S. 4,991,745) and Steinel (U.S. Pat. 6,575,340).
4. The present petition, filed on Feb. 8, 2008 requests withdrawal of the finality of the Office action mailed on Dec. 10, 2007 as premature.

Discussion and Analysis

The relevant portion of MPEP § 706.07(a): Final Rejection, When Proper on Second Action, states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner requests withdrawal of finality of the Office action mailed Dec. 10, 2007. Petitioner asserts that a second action on the merits should not be made final because the added limitations in the claims are reasonably expected to be claimed. The first search of prior art should have covered the invention and its concept as described and claimed. Petitioner relies on MPEP §§ 706.07(a) and § 904 to support his contention. This line of arguments is not convincing. The issue in the current petition is whether amended independent claims 1 and 4 changed the scope of original independent claims 1 and 4. If so, the new ground of rejection in the final Office action was necessitated by applicant's amendment.

In order to determine whether or not the original independent claims 1 and 4 and the amended independent claims 1 and 4 are identical in scope, a comparison of the claims must be made. The amended claims 1 and 4 are reproduced below with additions being underlined and deletion being bracketed or strikethrough.

The amended claims 1 and 4 filed on Sep. 20, 2007 are reproduced below:

1. (Currently amended) A valve configured to be inserted into a dispenser and engage a front wall of said dispenser comprising a disc of flexible material having a front wall and a rear wall, a central portion section formed between said front and rear walls, an annular portion contiguous with and surrounding said central section formed between said front and rear walls and including a marginal edge portion, wherein said [(a)] front wall of said central portion is displaced toward said rear wall from the front wall of said annular portion, [(a)] said rear wall of said annular portion is recessed toward said front wall from [(a)] said rear wall of said central portion and [(a)] said rear wall of said marginal edge, and said central portion is slit to provide at least one movable flap forming a valve for dispensing material.
4. (Currently amended) A dispenser forming a cavity for containing material to be dispensed and having a valve piston at one end of said cavity and a valve at an opposed end, wherein said dispenser has an internal wall and a front dispenser wall, and said valve comprises a disc with a front wall and a rear wall, a central portion section formed between said front and rear walls, an annular portion contiguous with and surrounding said central section formed between said front and rear walls, and including a marginal edge portion, wherein said [(a)] front wall of said central portion is displaced toward said rear wall from the front wall of said annular portion, [(a)] said rear wall of said annular portion is recessed toward said front wall from [(a)] said rear wall of said central portion and [(a)] said rear wall of said marginal edge, and said central portion is slit to provide at least one movable flap forming a valve for dispensing material and said front

wall of said annular portion engages said front dispenser wall and said marginal edge portion engages said internal wall.

A comparison of the amended independent claim 1 (with underlining and strikethroughs) and the original independent claim 1 (without underlining and strikethroughs) reveals that amended independent claim 1 now defines the specific valve structure inserted into a dispenser, a disk of flexible material with front and rear walls. Amended claim 1 further defines the details of a central section, annular portion contiguous with and surrounding said central section formed between front and rear walls, etc., whereas original claim 1 contains no such limitations. The newly amended independent claim 1 indeed changes the scope of original independent claim 1 because the limitations added to original independent claim 1 clearly shows a different valve structure. In view of the newly added limitations in claim 1, the examiner needed to search and found U.S. patent to Flier (US Pat. 4,616,768) for the rejection of amended claims 1 and 2. These added limitations to claim 1 in the amendment filed on Sep. 20, 2007 necessitated the new grounds of rejection in accordance with M.P.E.P. 706.07(a) mailed on Dec. 10, 2007.

A comparison of the amended independent claim 4 (with underlining and strikethroughs) and the original independent claim 4 (without underlining and strikethroughs) reveals that the amended independent claim 4 now defines the specific dispenser structure with one piston at one end and a valve at the opposite end of the cavity. Claim 4 also added valve details of a disk with a front and rear walls. Amended claim 4 further defines the details of a central section, annular portion contiguous with and surrounding said central section formed between front and rear walls, etc., whereas original claim 4 contains no such limitations. The newly amended independent claim 4 indeed changes the scope of original independent claim 4 because the limitations added to original independent claim 4 clearly shows a different dispenser structure. In view of the newly added limitations in claim 4, the examiner needed to search and found U.S. patent to Flier (US Pat. 4,616,768) for the rejection of amended claim 4. These added limitations to claim 4 in the amendment filed on Sep. 20, 2007 necessitated the new grounds of rejection in accordance with MPEP § 706.07(a) mailed on Dec. 10, 2007.

Petitioner argues that the amendment of Sep. 20, 2007 merely clarifies claimed limitations without substantially changing the claimed subject matter. The Gordon patent applied in the first Office action is similar to the newly found Flier patent. There are no significant differences between the two primary references. Therefore, the application of the Flier patent was evidently not necessitated by any amendment to the claims. This line of arguments is not persuasive. As analyzed above, amended claims 1 and 4 add substantial detail structure to the valves and dispenser. In the final Office action of Dec. 10, 2007, the newly applied Flier patent is only applicable to the amended claims 1, 2 and 4 under 35 U.S.C. 102(b). In the first Office action of Jun. 20, 2007, the Gordon patent was applicable toward original claims 1, 4, 6 and 7. This is evidence of the necessitation of a new reference in meeting the added claim limitations.

Petitioner also argues that the added limitations to claims 1 and 4 should have been reasonably expected. This line of argument is speculative. In view of the lengthy added limitations in claims 1 and 4, there is no reasonable expectation that the examiner would anticipate the applicant to add such detailed structure of the valve and dispenser in the claims. As also stated in MPEP § 706.07(a):

**>However, note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112, second paragraph)<.

Finally, petitioner argues that the failure to cite Flier patent in the first Office action was simply an oversight on the part of PTO and not a direct result of the amendments to the claims. This line of argument is also speculative. Petitioner provides no proof to support this allegation. Moreover, MPEP §706.02 states, "Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided. Based on such guidance, it is possible the examiner had seen the reference and determined it was, at best, cumulative when the first Office action was prepared. Admittedly, this is speculative on the part of the undersigned, but certainly is a possibility why the reference may not have been cited, let alone applied.

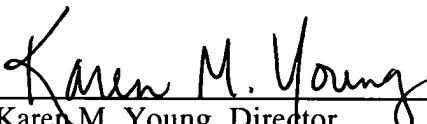
A review of the record shows that the examiner was in compliance with proper examining practice as set forth in MPEP 706.07(a). The finality of the Office action is appropriate.

Conclusion

For the foregoing reasons, the relief requested by petitioner will not be granted. Specifically, the finality of the Office action dated Dec. 10, 2007 is proper.

The application is being forwarded to Art Unit 3754 for waiting applicant's response to the final rejection of Dec. 10, 2007. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED.



Karen M. Young, Director
Technology Center 3700